

12. (Twice Amended) A system for providing a multiple-service card comprising:  
at least one service partner;  
a card service engine in communication with said at least one service partner; and  
at least one primary party in communication with said card service engine;  
wherein said at least one primary party provides a credit card service;  
wherein said at least one primary party is capable of receiving data from, and  
transmitting data to, said card service engine;

wherein said card service engine is configured to receive at a service partner establishment an application for a multiple-service card from a consumer, said application comprising credit card information and service partner information, said service partner information related at least in part to membership in the service partner establishment, and wherein said primary party is configured to determine whether or not it desires to extend credit to the consumer based on said application.

20. (Amended) A multiple-service card associated with which there is a service partner, a primary party and a holder, the card comprising:  
a first side and a second side,  
the first side having first indicia associated with said primary party,  
the second side having second indicia associated with said service partner,  
wherein said primary party is a provider of credit services and said service partner is a provider of membership club services.

## REMARKS

### I. Status of Claims

In the July 29, 2002, Office action, the Examiner rejected claims 1-29. In order to expedite prosecution of this case, Applicants have amended, without prejudice or disclaimer,

claims 1, 6, 12, and 20 and have canceled, without prejudice or disclaimer, claims 21 and 22. Support for the various amendments may be found in the originally filed specification, claims and figures; no new matter has been introduced. After entry of the foregoing amendments, claims 1-20 and 23-29 (4 independent claims, 23 dependent claims) remain pending in the application. Reconsideration is respectfully requested.

## **II. Rejection of Claims 20-22, 24-25, 27 and 29 Under 35 U.S.C. Section 102(b).**

In the July 29, 2002 Office action, the Examiner rejected claims 20-22, 24-25, 27 and 29 under 35 U.S.C. 102(b) as being unpatentable over Masaki, Japanese Patent No. 09-244,385 (hereinafter "Masaki"), published September 24, 1996. For the following reasons, reconsideration is respectfully requested.

In the Office action, the Examiner rejected Claims 20-22, 24-25, 27 and 29 on the grounds that Masaki discloses a multiple service card associated with which there is a service partner, a primary party, and a holder, the card comprising a first side and a second side, the first side having indicia associated with the primary party, the second side having indicia associated with the service partner, which is a provider of membership club services. Applicants respectfully assert that Masaki fails to teach, disclose or suggest every element of Claim 20, as amended, and claims 24-25, 27 and 29, which depend from Claim 20. Applicants have cancelled claims 21-22. Applicants respectfully traverse the Examiner's grounds for rejection.

Applicants have amended independent Claim 20 to recite that *the primary party is a provider of credit services and the service partner is a provider of membership club services*. Applicants respectfully submit that this amendment finds full support in the claims, specification, or drawings as filed. This claimed structure is distinct over the cited references for at least the following reasons. Neither Masaki nor any of the other cited references discloses, teaches, or suggests a multiple-service card associated with which there is a service partner, a primary party and a holder, *wherein the primary party is a provider of credit services and the service partner*

*is a provider of membership club services.* For example, in the two-sided card of Masaki, no mention whatsoever is made of any provider of credit services.

As disclosed at page 4 of the present specification, however, "the present invention enables a single card to function in multiple modes, for example as both a credit card and a separate service partner's membership card." The present invention accomplishes this benefit "[b]y providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers." Such cooperation provides the advantage that the decision whether or not to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner. This back-end functionality is implemented through extensive logic that performs the complex process steps, implemented through software and hardware, as described in great detail between pages 12 and 23 of the present application. For example, as described therein, a new account process is initiated when a prospective card member submits application information to a service partner. This application information contains not only a request for a credit card and a membership card, and is not simply an identification of an existing account, such as an account number, but comprises such additional information as is required in a typical credit application. This application information enables a provider of credit services *to decide* whether or not it is desirable to extend credit to the applicant.

Moreover, this back-end functionality enables an extensive series of process steps, implemented through complex hardware and software, to be performed to accomplish, among other things: (1) the retention of the service partner application information; (2) the extraction of appropriate credit application data; (3) the assignment of appropriate control numbers; (4) the forwarding of the credit application data to a primary party provider of credit services; (5) the evaluation and assessment of creditworthiness of the applicant; (6) the tracking of the application; (7) the return of an approval/declination decision; (8) the initiation of an account and its associated processing, statementing, billing, accounting, and servicing functions; (9) the sending of a multiple service card to the applicant; and the like. To implement this back-end

functionality so as to accomplish these and other steps requires an extensive set of program instructions not taught or even suggested by the prior art.

To the contrary, the systems and methods of the prior art make no provision to accommodate the complex process steps necessary to accomplish the benefits of the present invention. As a result, no system or method exists in the prior art that can, through a combination of software and hardware, effectively enable a provider of credit services and a provider of membership club services to cooperate so as to enable a single application received by either of the service providers to result in the provision of a multiple service card, where the multiple service card is configured to provide access to both membership club services and credit card services, and wherein the decision to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner.

The system of the instant invention, on the other hand, does incorporate such back-end functionality, through a combination of software and hardware, and it is this back-end functionality that enables beneficial cooperation between the service providers. Accordingly, Applicants' invention enables a multiple service card to be provided without requiring creditworthiness to have been predetermined and without requiring the credit provider to waive its ability to extend, or decline to extend, credit to the applicant. Such cooperation provides the advantage that the decision whether or not to extend credit may be made by the primary party provider of credit services *before* the multiple service card is provided. Thus, it is a substantial and novel advantage that the present invention provides communication of an application between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card. Accordingly, Applicants respectfully submit that this rejection under 35 U.S.C. § 102(b) is improper and respectfully request reconsideration and withdrawal of this rejection.

### **III. Rejection of claims 1-19 under 35 U.S.C. 103(a).**

In the July 29, 2002 Office action, the Examiner rejected claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,969,318, which issued October 19, 1999 to Mackenthun ("Mackenthun") in view of U.S. Pat. No. 6,032,136, which issued February 29, 2000 to Brake, et al. ("Brake") and U.S. Pat. No. 6,386,444, which issued May 14, 2002 to Sullivan ("Sullivan"). For the following reasons, reconsideration is requested.

In the Office action, the Examiner admits that Mackenthun does not teach either the step of authorizing the credit card information, the step of communicating to the service partner, or the limitation that the multiple-service card is configured for providing a primary party's services and a service partner's services. The Examiner asserts, however, that Brake teaches the above limitations by verifying the customer's information before adding a secondary service to the primary service and both primary feature/indicia and secondary feature/indicia present on the multiple service card. The Examiner contends that it would have been obvious to an artisan of ordinary skill in the art to incorporate the teachings of Brake into the teachings of Mackenthun to produce Applicants' claimed invention.

The Examiner also admits that Mackenthun as modified by Brake fails to teach the method of receiving at a service partner establishment an application and that the service partner information is related at least in part to membership in the service partner establishment. The Examiner asserts, however, that Sullivan teaches the above limitations in its system and methods for card payment instrument with rebate applied to an insurance premium. The Examiner contends that it would have been obvious to an artisan of ordinary skill in the art to incorporate the teachings of Sullivan into the teachings of Mackenthun and Brake to produce Applicants' invention as described in claims 1-19. For the following reasons, Applicants respectfully traverse the Examiner's grounds for rejection. Applicants respectfully submit that the cited references do not teach, hint, suggest, or disclose the elements of the present invention as disclosed and claimed.

With regard to the §103 rejections of Claims 1-19, "[i]t is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [applicant's] invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over Mackenthun, Brake, or Sullivan, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner because Mackenthun, Brake and Sullivan fail to disclose every element appearing in claims 1-19.

Specifically, Applicants have amended claims 1, 6, and 12 to clarify that it is credit card **application** information that is communicated to a provider of credit services, that the provider of credit services is configured to thereafter determine whether or not it desires to extend credit to the consumer, and further that the multiple-service card is caused to be sent to the consumer only if the provider of credit services desires to extend credit to the consumer. Applicants respectfully submit that these amendments find full support in the claims, specification, or drawings as filed. This claimed structure is distinct over the cited references for at least the following reasons.

As discussed above, neither Mackenthun, Brake, Sullivan nor any of the other cited references, alone or in combination, discloses, teaches, or suggests a system or method for providing a multiple service card wherein credit card **application** information is communicated to a provider of credit services so that the provider of credit services **may thereafter determine** whether or not it desires to extend credit to the consumer, and if so, the multiple-service card may be caused to be sent to the consumer. As disclosed at page 4 of the present specification, however, "the present invention enables a single card to function in multiple modes, for example as both a credit card and a separate service partner's membership card." The present invention accomplishes this benefit "[b]y providing a system of back-end functionality that takes



advantage of cooperation between the multiple service providers." This back-end functionality is implemented through extensive logic that performs a combination of appropriate process steps, implemented through complex software and hardware, as described in great detail between pages 12 and 23 of the present application.

For example, as described therein, a new account process is initiated when a prospective card member submits application information to a service partner. This application information contains not only a request for a credit card and a membership card, and is not simply an identification of an existing account, such as an account number, but comprises such additional information as is required in a typical credit application. This application information is sufficient to enable a provider of credit services *to decide* whether or not it is desirable to extend credit to the applicant. As discussed above, such cooperation is beneficial because it is not typically desirable that the decision to extend credit be made unilaterally by only the service partner. Moreover, such cooperation enables more considered decision-making than mere verification of application information that is suggested by Brake. Thus it is advantageous to provide a means for communication and cooperation, for example, between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card and, based on that decision, to affect the system and method accordingly. For this reason, Applicants' invention provides for communication of credit card *application* information to a provider of credit services to enable the provider of credit services to thereafter determine whether or not it desires to extend credit to the consumer, and if so, for the multiple-service card to be caused to be sent to the consumer.

Moreover, this back-end functionality enables an extensive series of process steps, implemented through complex software and hardware, to be performed to accomplish, among other things: (1) the retention of the service partner application information; (2) the extraction of appropriate credit application data; (3) the assignment of appropriate control number(s); (4) the forwarding of the credit application data to a primary party provider of credit services; (5) the

evaluation and assessment of creditworthiness of the applicant; (6) the tracking of the application; (7) the return of an approval/declination decision; (8) the initiation of an account and its associated processing, statementing, billing, accounting, and servicing functions; (9) the sending of a multiple service card to the applicant; and the like. To implement this back-end functionality so as to accomplish these, and other, steps requires an extensive set of program instructions not taught or even suggested by the prior art.

To the contrary, the systems and methods of the prior art make no provision to accommodate such a combination of interdependent process steps implemented through software and hardware so as to accomplish the benefits of the present invention. As a result, no system or method exists in the prior art that can effectively enable a provider of credit services and a provider of membership club services to cooperate so as to enable a single application received by either of the service providers to result in the provision of a multiple service card, where the multiple service card is configured to provide access to both membership club services and credit card services, and wherein the decision to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner.

The system of the instant invention, on the other hand, does incorporate such back-end functionality, and it is this back-end functionality that enables beneficial cooperation between the service providers. Accordingly, Applicants' invention enables a multiple service card to be provided without requiring creditworthiness to have been predetermined and without requiring the credit provider to waive its ability to extend, or decline to extend, credit to the applicant. Such cooperation provides the advantage that the decision whether or not to extend credit may be made by the primary party provider of credit services *before* the multiple service card is provided. Thus, it is a substantial and novel advantage that the present invention provides communication of an application between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card.



In the system and method of Sullivan, however, what is communicated from the service partner to the provider of credit services is merely the identification, or number, of a *pre-existing credit card account*, from which the rebates are to be generated. Sullivan does not provide any mechanism through which its provider of credit services may decide whether or not it desires to extend credit to a consumer. Accordingly, Sullivan teaches that either a credit card must be pre-existing or must be established without the prior approval of the issuer. As discussed above, however, Applicants' invention does not require a pre-existing credit card and enables the provider of credit services *to decide* whether or not to issue credit before the multiple service card is issued.

Thus, even if the cited prior art references were combined, which Applicants argue there is no motivation to do except in hindsight, the combination would not produce Applicants' novel invention, and thus, cannot obviate it. Moreover, the Office action fails to identify where, in any of the cited prior art references, the suggestion exists that Mackenthun either should be or could be modified by the teachings in Brake or Sullivan to achieve the present invention. Applicants were the first to recognize the advantage of receiving an application at a service partner establishment, where the application includes service partner information and credit card application information and wherein the credit card application information is communicated to a provider of credit services so that the provider of credit services may thereafter determine whether or not it desires to extend credit to the consumer, and if so, the multiple-service card may be caused to be sent to the consumer. The Office action has not met its burden in establishing a prima facie case of obviousness. Therefore, reconsideration and withdrawal of these rejections are respectfully requested.

In sum, neither Mackenthun, Brake, Sullivan nor any other cited reference discloses, teaches, hints, or suggests every element of claims 1, 6, and 12, so the rejection of these claims, and the rejection of claims 2-5, 7-11, and 13-19, which depend from claims 1, 6, and 12, is improper.

#### **IV. Rejection of claims 23, 26, and 28 under 35 U.S.C. 103(a).**

In the July 29, 2002 Office action, the Examiner rejected claims 23 and 26 under 35 U.S.C. 103(a) as being unpatentable over Masaki in view of U.S. Pat. No. 6,224,109, which issued May 1, 2001 to Yang ("Yang"). In addition, the Examiner rejected claim 28 under 35 U.S.C. 103(a) as being unpatentable over Masaki in view of U.S. Pat. No. 6,089,611, which issued July 18, 2000 to Blank ("Blank"). For the following reasons, Applicants respectfully traverse the Examiner's grounds for rejection. Applicants respectfully submit that the cited references do not teach, hint, suggest, or disclose the elements of the present invention as disclosed and claimed.

With regard to the §103 rejections of Claims 1-19, "[i]t is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct [applicant's] invention from such prior art." *In re Shuman*, 361 F.2d 1008, 1012 (C.C.P.A. 1996). The present claims, as amended, define an invention that is not obvious over Masaki, Yang or Blank, taken singularly or in combination. The Office has not identified any reference, either singularly or in combination, that teaches, hints, suggests, or discloses the specific combination recited in the claims. Applicants respectfully submit that a *prima facie* case of obviousness has not been made out by the Examiner because Masaki, Yang or Blank fail to disclose every element appearing in claims 23, 26, and 28.

Specifically, as discussed above, Applicants have amended claim 20 to recite that *the primary party is a provider of credit services and the service partner is a provider of membership club services*. Claims 23, 26, and 28 depend from amended claim 20. Applicants respectfully submit that this amendment finds full support in the claims, specification, or drawings as filed. This claimed structure is distinct over the cited references for at least the following reasons.

As discussed above neither Masaki nor any of the other cited references, alone or in combination, discloses, teaches, or suggests a multiple-service card associated with which there is a service partner, a primary party and a holder, *wherein the primary party is a provider of credit services and the service partner is a provider of membership club services*. For example, in the two-sided card of Masaki, no mention whatsoever is made of any provider of credit services.

As disclosed at page 4 of the present specification, however, "the present invention enables a single card to function in multiple modes, for example as both a credit card and a separate service partner's membership card." The present invention accomplishes this benefit "[b]y providing a system of back-end functionality that takes advantage of cooperation between the multiple service providers." Such cooperation is advantageous because it is usually desired that the decision to extend credit not be made unilaterally by only the service partner. This back-end functionality is implemented through extensive logic that performs the various complex process steps, implemented through hardware and software, as described in great detail between pages 12 and 23 of the present application. For example, as described therein, a new account process is initiated when a prospective card member submits application information to a service partner. This application information contains not only a request for a credit card and a membership card, and is not simply an identification of an existing account, such as an account number, but comprises such additional information as is required in a typical credit application. This application information enables a provider of credit services *to decide* whether or not it is desirable to extend credit to the applicant.

Moreover, this back-end functionality, as implemented through complex software and hardware, enables an extensive combination of process steps to be efficiently and reliably performed to accomplish, among other things: (1) the retention of the service partner application information; (2) the extraction of appropriate credit application data; (3) the assignment of appropriate control number(s); (4) the forwarding of the credit application data to a primary party provider of credit services; (5) the evaluation and assessment of creditworthiness of the

applicant; (6) the tracking of the application; (7) the return of an approval/declination decision; (8) the initiation of an account and its associated processing, statementing, billing, accounting, and servicing functions; (9) the sending of a multiple service card to the applicant; and the like. To implement this back-end functionality so as to accomplish these, and other, steps requires an extensive set of program instructions implemented in hardware and software, which is not taught or even suggested by the prior art.

To the contrary, the systems and methods of the prior art make no provision to accommodate the complex process steps, implemented through software and hardware, necessary to accomplish the benefits of the present invention. As a result, no system or method exists in the prior art that can effectively enable a provider of credit services and a provider of membership club services to cooperate so as to enable a single application received by either of the service providers to result in the provision of a multiple service card, where the multiple service card is configured to provide access to both membership club services and credit card services, and wherein the decision to extend credit does not need to have been predetermined or alternatively to be made unilaterally by only the service partner.

The system of the instant invention, on the other hand, does incorporate such back-end functionality implemented in hardware and software, and it is this back-end functionality that enables beneficial cooperation between the service providers. Accordingly, Applicants' invention enables a multiple service card to be provided without requiring creditworthiness to have been predetermined and without requiring the credit provider to waive its ability to extend, or decline to extend, credit to the applicant. Such cooperation provides the advantage that the decision whether or not to extend credit may be made by the primary party provider of credit services *before* the multiple service card is provided. Thus, it is a substantial and novel advantage that the present invention provides communication of an application between the primary party provider of credit services and the service partner provider of membership club services so as to enable the primary party provider of credit services *to decide* whether or not it is desirable to extend credit to the potential holder of the card.

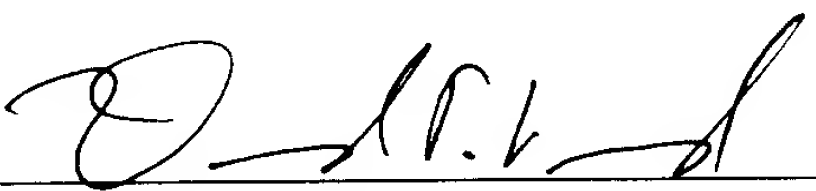
Thus, even if the cited prior art references were combined, which Applicants argue there is no motivation to do except in hindsight, the combination would not produce Applicants' novel invention, and thus, cannot obviate it. Moreover, the Office action fails to identify where, in any of the cited prior art references, Masaki either should be or could be modified by the teachings in Yang or Blank to achieve the present invention. Applicants were the first to recognize the advantage of providing a multiple-service card associated with which there is a service partner, a primary party and a holder, wherein the primary party is a provider of credit services and the service partner is a provider of membership club services. The Office action has not met its burden in establishing a *prima facie* case of obviousness. Therefore, reconsideration and withdrawal of these rejections are respectfully requested.

In sum, neither Masaki, Yang, Blank nor any other cited reference discloses, teaches, hints, or suggests every element of claim 20, so the rejection of claims 23, 26, and 28, which depend from claim 20, is improper.

#### **V. Conclusion**

In view of the foregoing, Applicants respectfully submit that all of the pending claims fully comply with 35 U.S.C. Section 112 and are allowable over the prior art of record. Accordingly, reconsideration of the application and allowance of all pending claims is earnestly solicited. The undersigned would welcome a telephone call at the telephone number listed below if such would advance prosecution of this application.

Respectfully submitted,

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## VERSION OF CLAIMS WITH MARKINGS TO SHOW CHANGES MADE

### In The Claims

1. (Twice Amended) A method for providing a multiple-service card, the method comprising the steps of:

receiving at a service partner establishment an application for a multiple-service card from a consumer, said application comprising credit card information and service partner information, said service partner information related at least in part to membership in the service partner establishment;

communicating said credit card application information to a provider of credit services, wherein said provider of credit services is configured to thereafter determine whether or not it desires to extend credit to the consumer; and

if said provider of credit services desires to extend credit to the consumer, causing a multiple-service card to be sent to the consumer, wherein said multiple-service card is configured for providing a primary party's services and a service partner's services.

6. (Twice Amended) A method for providing a multiple-service card, the method comprising the steps of:

receiving from a service partner establishment an application for a multiple-service card from a consumer, said application comprising credit card information and membership card information, said membership card information related at least in part to membership in the service partner establishment;

determining whether or not it is desired to extend credit to the consumer  
[authorizing said credit card information];

if it is desired to extend credit to the consumer, communicating said membership card information to a provider of membership services; and

causing a multiple-service card to be sent to the consumer.



12. (Twice Amended) A system for providing a multiple-service card comprising:  
at least one service partner;  
a card service engine in communication with said at least one service partner; and  
at least one primary party in communication with said card service engine;  
wherein said at least one primary party provides a credit card service;  
wherein said at least one primary party is capable of receiving data from, and  
transmitting data to, said card service engine;  
wherein said card service engine is configured to receive at a service partner  
establishment an application for a multiple-service card from a consumer, said application  
comprising credit card information and service partner information, said service partner  
information related at least in part to membership in the service partner establishment, and  
wherein said primary party is configured to determine whether or not it desires to extend credit to  
the consumer based on said application.

20. (Amended) A multiple-service card associated with which there is a service  
partner, a primary party and a holder, the card comprising:  
a first side and a second side,  
the first side having first indicia associated with said primary party.  
the second side having second indicia associated with said service partner,  
wherein said primary party is a provider of credit services and said service partner  
is a provider of membership club services.